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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/592,660	06/13/2000	Neil W. Black	03797.86776	7450

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EXAMINER

POINVIL, FRANTZY

ART UNIT

PAPER NUMBER

3628

DATE MAILED: 09/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/592,660

Applicant(s)

BLACK ET AL.

Examiner

Frantzy Poinvil

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

35 U.S.C. 101 reads as follows:

Claims 1-2, 17-18 and 28-37 remain rejected under 35 U.S.C. 102(e) as being anticipated by Wallman (US Patent No. 6,360,210) as set forth in the prior Office action.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3-16 and 19-27 remain rejected under 35 USC 103(a) as being unpatentable over Wallman (US Patent No. 6,360,210) as set forth in the prior Office action.

- 3.

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ARGUMENTS

Applicant's representative argues that Wallman relates to methods and systems that enable investors to seek prices for and purchase insurance in an effort to manage risks associated with a particular investment portfolio and fails to teach or suggest the claimed features of the independent claims.

In response, the Examiner respectfully disagrees with the applicant's assertion. While Wallman does provide means for insuring against risks associated with a particular investment portfolio, it should not be ignored that in the process, Wallman also teaches and suggests the claimed invention as indicated in the prior Office action. Wallman discloses that a customer or investor using a graphical user interface enters information for creating a portfolio. Typical investment data includes a type of issue, the number of shares or a percentage of each issue and time data for creating the portfolio. See column 6, lines 8-40 of Wallman.

Applicant then argues that Wallman relates to the level or amount of insurance a user desires to purchase to protect against a previously defined portfolio.

In response, Wallman does disclose such and further discloses a user may select options based on the type of selected issues. Applicant is also directed to column 6, lines 8-65 and column 8, lines 35-53 of Wallman.

Applicant then argues that Wallman fails to teach or suggest a user interface having at least two display portions.

In response, Wallman does not state such. However, graphical user interface having at least two display portions for inputting information or for retrieval or reviewing information is old and well known in the art and is routinely applied in the art. It would have been obvious to one of ordinary skill in the art at the time of the invention to include a graphical user interface having at least two display portions in the system of Wallman in order to divide related information into different sections so as to provide users with an instant view or entry of information.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 17-33 are rejected under 35 USC 101 because it is directed to non-statutory subject matter, specifically as directed to an abstract idea.

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The basis of this rejection is set forth in a two prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts. In the present case, claims 17-33 do not recite any structure or functionality to suggest that a computer performs the recited claims. Other dependent claims recite a server or a computer storage for storing information. As per these features, the mere storage of data not being executed by a processor or a computer does not render a claim statutory. Thus, claims 17-33 are rejected as being directed to non-statutory subject matter.

Claims 1-16 and 34-37 are rejected under 35 USC 101 because they are directed to non-statutory subject matter, specifically as directed to an abstract idea.

Computer program not claimed as embodied in computer media executable by a processor or a computer are descriptive material per se and are not statutory because they are neither physical "thing" nor statutory processes. The claims recite a program for creating a portfolio of issues that do not define any structural and functional

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interrelationships with a general purpose computer for permitting the claimed functions to be realized. In contrast, a statutory claim would define structural and functional interrelationships between data structures or functional parts and a computer for performing the data functions to be realized. Thus claims 1-16 and 34-37 are rejected as being non-statutory.

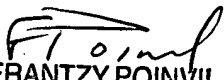
Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantzy Poinvil whose telephone number is (703) 305-9779. The examiner can normally be reached on Monday-Thursday 7:00AM-5:30PM.

The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9326 for Before Final actions and (703) 872-9327 for After Final actions.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

FP
September 10, 2003


FRANTZY POINVIL
PRIMARY EXAMINER
Au 3628